SUPPORT FOR THE AMENDMENT

This Amendment amends Claims 1-13; cancels Claims 14-16; and adds new Claims 17-24. Support for the amendments is found in the specification and claims as originally filed. In particular, support for the "self-supporting" limitation of independent Claim 13 is found in the specification at least at page 7, line 19 ("the substrate layer serves as a *support*"). Support for new Claims 17-19 is found in the specification at least at page 6, lines 1-5. Support for new Claims 20-21 is found in the specification at least at page 2, lines 38-40. Support for new Claim 22 is found in the specification at least at page 6, lines 17-18. Support for new Claim 23 is found in the specification at least at page 2, lines 13-15. Support for new Claim 24 is found at least in Claim 10. No new matter would be introduced by entry of these amendments.

Upon entry of these amendments, Claims 1-13 and 17-24 will be pending in this application. Claim 13 is independent.

REQUEST FOR RECONSIDERATION

Applicants respectfully request entry of the foregoing and reexamination and reconsideration of the application, as amended, in light of the remarks that follow.

Applicants thank the Examiner for the courtesies extended to their representative during the April 24, 2003, personal interview.

As discussed at the interview, the present invention provides the self-supporting, radiation-curable, composite layered sheet or film that, when bonded on a molding or other surface, provides improved scratch resistance and mechanical elasticity.

Claims 1-2, 5-7, 12 and 15-16 are rejected under 35 U.S.C. § 102(e) over U.S. Patent No. 6,380,279 ("Moens"). In addition, Claims 3-4 and 14-15 are rejected under 35 U.S.C. § 103(a) over Moens.

Moens discloses radiation-curable powder compositions, usable as paint or varnish, which comprise a mixture of at least one semi-crystalline polyester containing end methacryloyl groups and at least amorphous polyester containing end methacryloyl groups. Moens at Abstract. Moens discloses that the powder compositions can be coated onto diverse substrates and articles by deposition in a fluidized bed or by application with a triboelectric or electrostatic spray gun. Moens at, e.g., column 12, lines 38-42, 59-67.

However, Moens fails to disclose, teach or suggest the independent Claim 13 limitation of a "self-supporting, radiation-curable, composite layered sheet or film".

Thus, the rejections over Moens should be withdrawn.

New Claim 21 is further patentably distinguishable over Moens, because Moens' disclosure of radiation-curable polyester powder compositions fails to suggest the Claim 21 limitation that "the binder comprises an ethylenically unsaturated member of the group consisting of polyethers, polycarbonates, polyepoxides and polyurethanes".

Claims 1-9 are rejected under 35 U.S.C. § 101 and under 35 U.S.C. § 112, because of the recitation of a "use". To obviate the rejections, Claims 1-9 are amended.

Claims 1-16 are rejected under 35 U.S.C. § 112, second paragraph, because assertedly:

> It has been held that claims merely setting forth physical characteristics desired in an article, and not setting forth specific compositions which would meet such characteristics, are invalid as vague, indefinite, and functional since they cover any conceivable combination of ingredients either presently existing or which might be discovered in the future and which would impart the desired characteristics, See, Austenal Laboratories, Inc. v. Nobilium Processing Company, 115 USPQ 44 [(D.Ill. 1957)] and Ex parte Slob 157 USPQ 172 [(Pat. & Trademark Office Bd. App. 1967)]. In this instance the applicants have merely recited a radiation curable composition which has a Tg of greater than 40 deg. C. Office Action at section 4, lines 4-10.

The Office Action's reliance on Austenal and Slob is misplaced.

MPEP § 2173.04 states:

> Breadth of a claim is not to be equated with indefiniteness. *In re Miller*, 441 F. 2d 689, 169 USPQ 597 (CCPA 1971). If the scope of the subject matter embraced by the claims is clear, and if applicants have not otherwise indicated that they intend the invention to be of a scope different from that defined in the claims, then the claims comply with 35 U.S.C. § 112, second paragraph.

Miller was decided by the CCPA in 1971, after Slob was decided by the Patent Office Board of Appeals in 1967 and Austenal was decided by District Court of Illinois in 1957. The Federal Circuit adopted the law of the CCPA when the Federal Circuit was established (see, South Corp. v. United States, 215 USPQ 657 (Fed. Cir. 1982), copy attached). Thus, instead of Austenal and Slob, the CCPA's decision in Miller is controlling law.

Not surprisingly, the MPEP does not include Austenal and Slob in the List of Decisions Cited at Appendix II.

Because breadth is not indefiniteness, and independent Claim 13 clearly informs the public as to the boundaries of what would constitute infringement, the claims meet the requirements of 35 U.S.C. § 112, second paragraph. Thus the rejection of Claims 1-16 under 35 U.S.C. § 112, second paragraph, should be withdrawn.

Applicants respectfully request that the Examiner indicate by a statement in the next Office Action that the documents cited in the International Search Report filed October 22, 2001, have been considered.

In view of the foregoing amendments and remarks, Applicants respectfully submit that the application is in condition for allowance. Applicants respectfully request favorable consideration and prompt allowance of the application.

Should the Examiner believe that anything further is necessary in order to place the application in even better condition for allowance, the Examiner is invited to contact Applicants' undersigned attorney at the telephone number listed below.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER AND NEUSTADT, P.C.

Norman F. Oblon
Registration No. 24,618
Attorney of Record

Corwin P. Umbach, Ph.D.
Registration No. 40,211

Attachment:
South Corp. v. United States, 215 USPQ 657 (Fed. Cir. 1982)

22850

(703) 413-3000
(703) 413-2220 (fax)

NFO:CPU/bwt
I:\atty\Cpu\May03\215157us-revam.wpd